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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,672	02/23/2004	Michael P. Whitman	11443/160	2683

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NEW YORK, NY 10004

EXAMINER

WEEKS, GLORIA R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/785,672

Applicant(s)

WHITMAN ET AL.

Examiner

Gloria R. Weeks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-106 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☒ Claim(s) 1-106 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Group I. Claims 1-10 & 70-78, drawn to a surgical device having an axially lockable anvil and method of use, classified in class 227, subclass 175.2.
  - Group II. Claims 11-20 & 79-87, drawn to a surgical device having a stapler pusher shear pin method of use, classified in class 227, subclass 180.1.
  - Group III. Claims 21-27, drawn to a surgical device having a cutting element shear pin, classified in class 227, subclass 180.1.
  - Group IV. Claims 28-40, drawn to a surgical device having specific stapler cartridge, classified in class 227, subclass 176.1.
  - Group V. Claims 41-50, drawn to a surgical device having an interference element, classified in class 227, subclass 175.1.
  - Group VI. Claims 51-60, drawn to a surgical device having a rotatable pusher element, classified in class 227, subclass 175.1.
  - Group VII. Claims 61-70, drawn to a surgical device sleeve, classified in class 227, subclass 175.1.
  - Group VIII. Claims 71-99, drawn to a surgical device having a trocar shaft and a cable extension element, classified in class 227, subclass 175.1.
  - Group IX. Claims 100-106, drawn to a surgical device having a trocar shaft and an anvil sleeve, classified in class 227, subclass 175.1.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of at least two drives, an axially lockable anvil, and a controller, the sum of which is not required by the surgical device of Group II. The surgical device of Group II requires the use of a shear pin to connect the stapler housing to the stapler pusher, as well as the use of a plurality of pusher fingers, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of at least two drives, an axially lockable anvil, and a controller, the sum of which is not required by the surgical device of Group II. The surgical device of Group III requires the use of a shear pin to connect the stapler housing to the cutting implement, which is not required by the surgical device of Group I.

Inventions of Group II and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group II, which requires the use of a shear pin to connect the stapler housing to the stapler pusher, as well as the use of a plurality of pusher fingers, the sum of which is not required by the surgical device of Group III. Although

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the surgical device of Group III requires the use of a shear pin, the shear pin of Group III is functions to connect the stapler housing to the cutting implement, which is not required by the surgical device of Group II.

Inventions of Group I and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group IV. The surgical device of Group IV requires the use of a stapler cartridge defining openings and staple guides arranged in two radially-spaced rows, as well as the use of at least two pusher fingers, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group V. The surgical device of Group V requires the use of an interference element, as well as the use of an axially lockable staple cartridge, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group VI. The surgical device of Group VI requires the use of a rotatable pusher element including a cam element and rotatable member, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group IV. The surgical device of Group VII requires the use of a sleeve and a closure element, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group IV. The surgical device of Group VIII requires the use of a trocar shaft and a cable extension element, the sum of which is not required by the surgical device of Group I.

Inventions of Group I and Group IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions are the surgical device of Group I, which requires the use of an axially lockable anvil and a controller, the sum of which is not required by the surgical device of Group IV. The surgical device of Group IX requires the use of a trocar shaft and an anvil sleeve, the sum of which is not required by the surgical device of Group I.

3. Because these inventions are distinct for the reasons given above and the search required for each of Groups I-IX different, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 65-105 have been renumbered 65-106. Claim 34 is objected to because of the following informalities: Claim 34 claims dependency from claim 1, however, the

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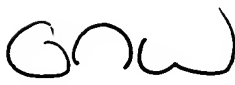
limitations of claim 34 would invoke a 35 USC 112 2<sup>nd</sup> Paragraph rejection due to lack of antecedent basis, if claim 34 is indeed dependant upon claim 1. Examiner has thus viewed the dependency of claim 34 on claim 1 to be a typographical error, and should be dependant upon claim 31. Appropriate correction is required.

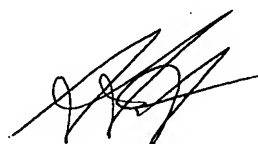
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria R. Weeks whose telephone number is (571) 272-4473. The examiner can normally be reached on 8:30 am - 7:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
grw  
July 20, 2005

  
SCOTT A. SMITH  
PRIMARY EXAMINER

Gloria R Weeks  
Examiner  
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